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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,530	05/15/2001	Reto Sieber	F 6817	5031

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Jordan and Hamburg
122 East 42nd Street
New York, NY 10168

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/762,530	Applicant(s) SIEBER ET AL.	
	Examiner Nasser Ahmad	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11,16-19 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11,16-19 and 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Withdrawn

1. Claims 11, 16-19 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal (GB: 2063710) for reasons of record made in the last Office Action of 2/22/2006.
2. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal in view of Su (5462782) for reasons of record made in the last Office Action of 2/22/2006.
3. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal for reasons of record made in the last Office Action of 2/22/2006.
4. **The rejections made in the last Office action have been repeated herein for applicant's convenience** (with correction by removing the erroneous reference to cancelled claim 14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11, 16-19 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal (GB: 2063710).

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Marchal relates to a self-adhesive sheet (see figure-3) consisting of a backing layer (11) having a top surface and a bottom surface, a first pressure sensitive adhesive (PSA) (11B) coating on the entire top surface of said backing and the coated top surface being planar, and a second PSA (11A1) coating coated on the bottom surface of the backing layer and the coated bottom surface being planar. The backing layer comprises a polymer film or a textile sheet arranged on the top surface of the backing such as when treated to make it impermeable (page-2, lines 116-119). The textile structure would include weave of intersecting threads and hence, a meshed arrangement

The different adhesive pattern provided on the top surface and the bottom surface would provide for different adhesive strengths of the two PSAs. As shown in figure-1, the adhesive sheet has a removable cover film (3) adhered to the top surface of the backing layer. The self-adhesive sheet has a certain width dimension. However, Marchal fails to teach that the minimum width of the sheet is 350 mm. It would have been obvious to one having ordinary skill in the art to modify Marchal by providing its adhesive sheet to have a width of at least 350 mm, based on optimization through routine experimentation, as the reference is also directed to same area of application, that is, bonding floor covering to a floor as in the instant application and the coverage extent would be obvious optimization.

Marchal also relates to a method for bonding a floor covering to a floor comprising adhering the bottom surface of the adhesive sheet to a floor and adhering a floor covering to the top surface of the adhesive sheet (page-1, lines 5-12), wherein the floor covering can be a carpet.

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Regarding the particular textile structure thread spacing of 3 to 30 mm, it would have been obvious to modify the textile mesh structure of Marchal to have the thread spacing of 3 to 30 mm, based on optimization through routine experimentation, to provide optimum structure to the backing layer.

The adhesive strength of the adhesive layers are different because of the different application, in that the second adhesive layer (11A1) has a patterned coat which would exhibit a strength lower than that of the first adhesive layer (11B) and the strength of 0.8 to 5 N (claims 14 and 22-23) would have been obvious based on optimization through routine experimentation.

The application rate of the adhesive in claims 19 and 24 have not been given any patentable weight because the process conditions in product claims and are not found to be germane to the issue of patentability of the product itself.

7. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal in view of Su (5462782).

Marchal, as discussed above, fails to teach that the backing layer polymer can be polyethylene. Su discloses a double-sided adhesive tape comprising a backing layer of polyethylene (abstract) to provide for strength to the structure. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Su's teaching of using a polyethylene backing as the backing layer in the invention of Marchal with the motivation to provide strength to the tape structure.

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As for the floor covering being parquet, Marchal broadly teaches floor covering which would include all flooring material such carpet and parquet. Hence, it would have been obvious to use floor covering of carpet or parquet, as said floor covering material are deemed to be functionally equivalent and use of one for the other would have been obvious to one having ordinary skill in the art.

8. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal. Marchal, as discussed above, fails to teach that the self-adhesive sheet comprises a second textile structure arranged on the bottom surface thereof. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide for the second textile structure on the bottom surface thereof for enhancing the reinforcing strength to the sheet, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

9. **Further, a new ground of rejection is provided for newly submitted claim 32 as follows:**

10. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal (GB: 2063710).

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Marchal relates to a self-adhesive sheet (see figure-3) consisting of a backing layer (11) having a top surface and a bottom surface, a first pressure sensitive adhesive (PSA) (11B) coating on the entire top surface of said backing and the coated top surface being planar, and a second PSA (11A1) coating coated on the bottom surface of the backing layer and the coated bottom surface being planar. The backing layer comprises a polymer film or a textile sheet arranged on the top surface of the backing such as when treated to make it impermeable (page-2, lines 116-119). The textile structure would include weave of intersecting threads and hence, a meshed arrangement

The different adhesive pattern provided on the top surface and the bottom surface would provide for different adhesive strengths of the two PSAs. As shown in figure-1, the adhesive sheet has a removable cover film (3) adhered to the top surface of the backing layer. The self-adhesive sheet has a certain width dimension. However, Marchal fails to teach that the minimum width of the sheet is 350 mm and that the threaded mesh is of a rhomboidal shape. It would have been obvious to one having ordinary skill in the art to modify Marchal by providing its adhesive sheet to have a width of at least 350 mm, based on optimization through routine experimentation, as the reference is also directed to same area of application, that is, bonding floor covering to a floor as in the instant application and the coverage extent would be obvious optimization.

Further, it would have been obvious matter of design choice to modify Marchal by providing the threaded mesh to have a rhomboidal shape because a such a

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modification involves a mere change in the shape of the threaded mesh. A change in shape is generally recognized to be within the level of one of ordinary skill in the art.

Response to Arguments

11. Applicant's arguments filed August 22, 2006 have been fully considered but they are not persuasive.

Applicant argues that *Marchal fails to teach providing a different coating strength based on the Coating itself apart from the coating placement or configuration and the reference fails to teach a structural range which includes 350 nm of both first and second adhesive coatings (top and bottom of the adhesive tape). Accordingly, the rejection is not proper.* This is not found to be convincing because Marchal clearly shows that the two adhesives are of different strength as explained in the last Office Action of 2/22/2006, irrespective of how the adhesive is applied, which is directed to a method of making the product.

Applicant also argues that *Marchal is directed to a double sided tape where the adhesive on both sides comprises a "very high bonding power". Marchal at line 79. Each adhesive is "equally powerful", Id. at line 107. To weaken the bonding power of the tape on one side, the reference provides patterns or holes 11A1 or 21. One following the teachings of Marchal would not be motivated to obviate the use of the patterns and holes and rather use an adhesive having a "lower adhesive strength" (claim 1), such as with the application of two different adhesives (claim 18) or adhesives having different strengths because of being formed by different application*

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rates (claim 17). Such a modification to Marchal obviates the principle operation and indeed the entire need for the Marchal invention which seeks to modify the strength of "equally powerful" adhesive~ disposed on each surface of the tape. Accordingly, the modification contemplated by the Examiner is not appropriate. This is not deemed to be convincing because both of Marchal's adhesive can be equally powerful, but when provided as shown in figure-3 of Marchal, each of the two adhesive would exhibit different adhesive strength as claimed. The process of making/applying the two adhesive is not germane to the issue of patentability of the product itself and hence, the process of making/applying is not given any patentable weight.

In response to applicant argument that *when referring to Fig. 3 of Marchal, the Examiner is incorrect when asserting that in this figure illustrates a planar bottom surface entirely coated with adhesive*, applicant is informed that said limitation could not be located in the claims (the claim fails to recite that the planar bottom surface is entirely coated with adhesive as alleged) and cannot be read thereinto for the purpose of avoiding the applied prior art.

Applicant argues that *Fig. 3 of Marchal shows the adhesive tape for clarity reasons in a reversed way. Thus, the Marchal reference fails to teach at least the feature of "a second pressure-sensitive adhesive coating coated on the bottom surface of said backing layer, said coated pressure-sensitive adhesive bottom surface being planar"* as currently recited in independent claims 11 and 32. Accordingly, Marchal fails to teach each recited limitation so that the rejection is not proper. This is not found to be persuasive because figure-3 of Marchal clearly shows that the second adhesive (11A) is

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on the bottom surface of the backing, as explained in the last Office Action, and said adhesive being planar.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is obvious over the prior art of record as discussed above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
October 24, 2006.